

REMARKS

Amendments to Specification

Subject matter headings have been introduced in the specification and paragraph [0007] has been deleted as irrelevant in a U.S. application.

Amendments to Claims

The claims have been amended to cure informalities noted during preparation of this paper and, with regard to claims 1 and 21, to more clearly recite the subject matter for which protection is sought.

Support for the amendments made to claim 1 are found in paragraph [0030].

Claim Rejections – 35 USC §103(a)

Claim 1 has been amended to recite that the two different feature substances enable checking of a value document for authenticity (counterfeit), while the second feature substance in the form of a coding enables checking of the value document for its value (denomination).

The examiner will recognize that none of the cited prior art discloses or suggests utilizing two different feature substances that enable checking the authenticity of a value document, while a second feature substance in the form of a luminescent substance in the form of a coding is used to enable recognition of the value of the document.

Cohen, disclosing a bar code on a tracking document, Kaule, disclosing a luminescent substance for checking authenticity, and Soules, showing coding substantially over a full surface of a playing card, individually and collectively fail to provide the remotest suggestion of using two different feature substances in a value document, such as a bank note, that can be used for checking authenticity of the document, while the second feature substance, in the form of a luminescent substance, is used to provide a coding that enables recognition of the value of the document.

Accordingly, it is respectfully submitted that claim 1 is fully patentable over the art of record and that withdrawal of the rejection of claim 1 is warranted.

Applicant submits that claims 2-14 are patentable at least on the basis of the patentability of claim 1 for the reasons given above. Moreover, the recitation in claim 1 that the first and second feature substances may be used for checking authenticity of a value

document, while a coding provided by the second feature substance that is a luminescent material also may be used for checking the value of a document, carries over into the dependent claims 2-14, which further recite properties of the first and second feature substances, as well as a third feature substance. It is respectfully submitted that claims 2-14 are also patentable in their own right when viewed as a whole, taking into account the elements recited in claim 1.

Claim 15 is drawn to the method for producing a value document of claim 1 wherein the first feature substance is incorporated into the volume of the value document substrate and the second feature substance is applied to the value document substrate in the form of a coding. It is respectfully submitted that claim 15 along with claims 16-20 dependent therefrom are likewise at least patentable on the basis of the patentability of claim 1 and further in view of the method steps recited in claim 15 for producing the document according to claim 1.

Claim 21 is drawn to the method for checking a document made according to claim 1, including checking the authenticity and value of the document by (i) checking the authenticity of the document using at least one characteristic property of either or both the first feature substance and the luminescent substance (the second feature substance), and (ii) using the coding formed by the luminescent second substance for carrying out value recognition of the value document. For reasons given previously with regard to the patentability of claim 1, it is submitted that claim 21 likewise, reciting the method for checking the authenticity and value of a value document, is patentable over all of the prior art of record which fails to show or suggest the recited process. Accordingly, withdrawal of the rejection of claim 21 is warranted and the same is respectfully requested.

Claims 22-28 are likewise patentable at least on the basis of the patentability of claim 21, and further in their own right when viewed individually as whole claims. In particular, claims 22-26 recite methods involving the characteristic properties of the feature substances or the coding provided by at least one of the feature substances to enable different levels of checking of documents, as described in the written description beginning at paragraph [0030] and continuing through paragraph [0034]. Also, checking of value documents at different levels of security by two user groups is further described in the specification at paragraphs [0041] – [0048]. None of the prior art is seen to be concerned whatsoever with the processes recited in claims 21-28.

The examiner's contention that Cohen in view of Kaule and further in view of Soules disclose a method for checking or processing a value document by checking the authenticity of the document using at least one characteristic property of either or both the first feature substance and the luminescent substance, and checking for the value of the document using a coding formed by the luminescent substance, thereby obviating the methods of claim 21-28, appears to be a strained exercise in hindsight, whereby the examiner has picked and chosen select elements from the individual prior art documents without benefit of the full context of what the documents actually teach to a person skilled in the art.

Admittedly, Cohen discloses a bar code on a tracking document, but the tracking document itself has no intrinsic value whatsoever. The bar code is informational only and is not used in combination with any other feature substance incorporated in the tracking document to provide information about authenticity of the document in combination with the bar code. The bar code itself simply provides a tracking number in bar code form, which is also duplicated on the face of the tracking document as illustrated in figure 3 of the patent.

The examiner, recognizing that Cohen falls far short of a teaching of checking authenticity and value of a document by using a characteristic property of either or both a first feature substance and a luminescent substance, while using a coding formed by the luminescent substance for checking the value of the document, reaches towards the teachings of Kaule and imputes to a person skilled in the art a motivation to incorporate a luminescent authenticity identifying substance (Kaule, the examiner will note, is only concerned with authenticity of a document, not value), and to use the substance in the tracking document of Cohen, which then would contain a first luminescent authenticity identification substance within the body of the document in combination with a printed bar code on the face of the document. *It is respectfully submitted that a person skilled in the art would have no motivation whatsoever to incorporate an authenticity identification luminescent substance in a tracking document where the tracking document has no intrinsic value.* In such a document, it is highly unlikely that the document will be checked for authenticity and there is nothing within the Cohen patent or in the realm of general knowledge that remotely suggests the desirability of modifying a tracking document in the manner suggested by the examiner to enable detection of authenticity of the tracking document.

The examiner also takes the position that Soules, with its coding spread over the face of a playing card, would be recognized by a person skilled in the art as providing a teaching

of modifying the tracking document of Cohen so that the bar code appears over the full surface of the document. Of course, the bar code would be invisible and would require highly refined detecting equipment to read the bar code, as is clearly described in Soules. Even if the bar code of Cohen was somehow modified in accordance with the teachings of Soules so that the code is spread over the entire face of the tracking document of Cohen, the code would provide nothing more than the tracking number of figure 3 of Cohen in invisible bar code form. The mythical person skilled in the art would still not be motivated in any manner to check both authenticity and value of the Cohen document using a characteristic property of either or both first and second feature substances, while using a coding of either Cohen or Soules to check the value of the tracking document (the tracking number).

It is respectfully submitted that the examiner has failed to establish a *prima facie* basis of obviousness in rejecting claims 21-28 in view of the teachings of Cohen, Kaule and Soules, and instead has used prohibited hindsight in stretching the teachings of the documents beyond what the documents themselves teach to persons skilled in the art. Such picking and choosing of individual features and arbitrarily mosaicing them into a cobbled concoction that is molded into a new but implausible combination corresponding to the claimed subject matter is improper on its face and warrants withdrawal of the rejection of claims 21-28.

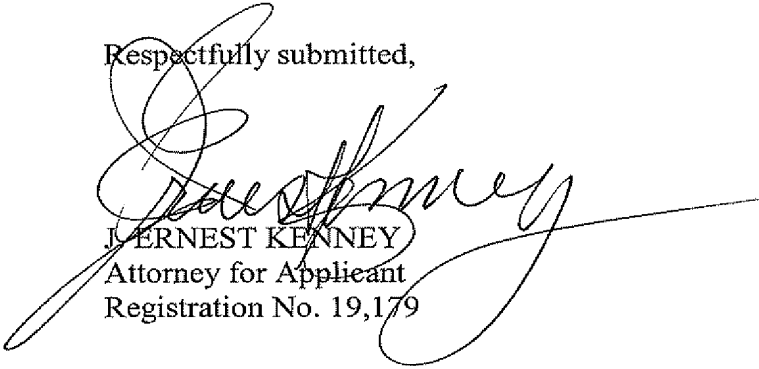
Claims 29-32 are patentable at least on the basis of the patentability of claim 1, from which they depend directly or indirectly, and further in their own right considered individually in their entirety.

Claims 33 and 34 are patentable at least on the basis of claims 18 and 19, from which they depend, for reasons given previously with regard to claims 18 and 19.

The application having been placed in condition for allowance, its passage to issue is respectfully requested.

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, VA 22314-1176
Phone: (703) 683-0500
Facsimile: (703) 683-1080
Date: September 15, 2008

Respectfully submitted,


ERNEST KENNEY
Attorney for Applicant
Registration No. 19,179